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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/866,651	05/30/2001	Masaaki Hiroki	740756-2321	5785

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EXAMINER

SANTIAGO, MARICELI

ART UNIT PAPER NUMBER

2879

DATE MAILED: 06/20/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Applicant(s)

09/866,651

HIROKI, MASAOKI

Examiner

Mariceli Santiago

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 January 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 16-38 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 16-38 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 30 May 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action: _____
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Response to Amendment

The Preliminary Amendment, filed on May 30, 2001, has been entered and acknowledged by the Examiner.

The Amendment, filed on January 7, 2003, has been entered and acknowledged by the Examiner.

Cancellation of claims 1-15 has been entered.

New claims 19-38 have been entered and acknowledged by the Examiner.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 16-38 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 16 recites the limitation "the EL layer" in line 6. There is insufficient antecedent basis for this limitation in the claim.

Claim 16 recites the limitation "the opposing detector substrate" in lines 11 and 14. There is insufficient antecedent basis for this limitation in the claim.

Claims 17-27 are rejected for the reasons stated in the rejection of claim 16 above because of their dependency status from claim 16.

Claim 28 recites the limitation "the EL layer" in line 5. There is insufficient antecedent basis for this limitation in the claim.

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Claims 29-38 are rejected for the reasons stated in the rejection of claim 16 above because of their dependency status from claim 16.

The term "soft X-ray" in claim 31 is a relative term which renders the claim indefinite. The term "soft" is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention. The recitation "soft X-ray" fails to properly define the magnitude of the X-ray wavelength.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claim 18 is rejected under 35 U.S.C. 102(b) as being anticipated by Suzuki et al. (US 5,537,054).

Regarding claim 18, here the Applicant is claiming the product of a light-emitting device including a method (i.e. a process) of making the light-emitting device, consequently, claim 16 is considered a "product-by-process" claim. In spite of the fact that a product-by-process claim may recite only process limitations, it is the product and not the recited process that is covered by the claim. Further, patentability of a claim to a product does not rest merely on the difference in the method by which the product is made. Rather, is the product itself which must be new and not obvious (see MPEP 2113). As such, patentability is based on the final product obtained which in the instance case is a light-emitting device comprising an element substrate having an electrode connected to a semiconductor element, and an EL layer in contact with the electrode

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connected to the semiconductor element. Suzuki discloses a light-emitting device comprising an element substrate having an electrode connected to a semiconductor element, and an EL layer in contact with the electrode connected to the semiconductor element. Furthermore, Suzuki discloses an alternative method in which the substrate element is inspected prior to completion of the display assembly.

Allowable Subject Matter

Claims 16, 17 and 19-38 would be allowable if rewritten or amended to overcome the rejection(s) under 35 U.S.C. 112, second paragraph, set forth in this Office action.

The following is a statement of reasons for the indication of allowable subject matter:

Regarding claims 16 and 28, the references of the Prior Art of record fails to teach or suggest the combination of the limitations as set forth in claims 16 and 28, and specifically comprising the limitation of the element substrate is inspected by emitting electromagnetic waves from a source of electromagnetic waves, ionizing a gas between the element substrate and an opposing detector substrate, measuring a current between the element substrate and the opposing detector substrate, and inspecting the current-flowing state of a pixel electrode of the element substrate.

Regarding claims 17 and 19-27, claims 17 and 19-27 are allowable for the reasons given in claim 16 because of their dependency status from claim 16.

Regarding claims 29-38, claims 29-38 are allowable for the reasons given in claim 28 because of their dependency status from claim 28.

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Other Prior Art Cited

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Contact Information

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mariceli Santiago whose telephone number is (703) 305-1083. The examiner can normally be reached on Monday-Friday from 7:00 AM to 3:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nimesh Patel, can be reached on (703) 305-4794. The fax phone number for the organization where this application or proceeding is assigned is (703) 308-7382. Additionally, the following fax phone numbers can be used during the prosecution of this application (703) 872-9318 (for response before a Final Action) and (703) 872-9319 (for response after a Final Action).

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0956.

MS 6/13/03
Mariceli Santiago
Patent Examiner
Art Unit 2879

Kenneth J. Ramsey
**KENNETH J. RAMSEY
PRIMARY EXAMINER**